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Dated: November 4, 2004 Signature: \_\_\_\_\_

Michael R. H. H.

Docket No.: 29985/01-028  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Timothy G.J. Ehr et al.

Application No.: 10/027,154

Confirmation No.: 1216

Filed: December 20, 2001

Art Unit: 3736

For: PRESSURE-SENSING GUIDEWIRE AND  
SHEATH

Examiner: Not Yet Assigned

**RESPONSE TO RESTRICTION REQUIREMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed October 4, 2004, Applicant hereby elects Group 1 (claims 1-26); Embodiment A (Figures 1-6 and 6); and Embodiment 1 (Figure 11) for continued examination *with traverse*.

An early action on the merits of Group I, Embodiment A, and Embodimen 1 is earnestly solicited.

Reconsideration and withdrawal of the restriction requirement is, however, requested in view of the following remarks.

The M.P.E.P. clearly and unequivocally states that there are two criteria which must be met for a requirement for restriction to be proper; (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803). In this instance, although the Office action argues that the groups of claims identified in the Office action are distinct, it fails to demonstrate that a serious burden would be placed on the Examiner if election were not required.

The applicants note that if there is a serious burden in the present application, it is on the applicant's assignee as a result of this restriction requirement. Unless the

restriction requirement is withdrawn, the applicant's assignee must not only prosecute separate applications, which multiplies the cost of obtaining protection for the inventive subject matter, but it must also then pay separate maintenance fees for each of the issued patents. It is respectfully submitted that the burden of the expense incurred in order to obtain two different patents and the further expense in maintaining those patents suffered by the taxpayer, far outweigh any possible burden the Patent Office may incur as a result of simultaneously examining the claims of this application.

In summary, the Office action fails to address the second required criteria for restriction set forth in the M.P.E.P. Embodiments A, B and C are so closely related that they clearly can all be covered in a single search. The Patent Office does not even allege that Embodiments A, B and C are in different subclasses. Similarly, Embodiments 1-4 are so closely related that they clearly can also be covered in a single search. The Patent Office does not even allege that Embodiments 1-4 are in different subclasses. The fact that there are three generic claims at this stage of the proceedings bolsters this point.

In view of the following mandate, this failure renders the restriction requirement improper:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). Therefore, applicant requests that the requirement for restriction be withdrawn. Moreover, because the restriction requirement is incomplete for failing to address the second requirement specified in the M.P.E.P., the applicant has not been afforded a fair opportunity to respond and the restriction requirement cannot properly be made "Final."

Claims 1-26 read on elected Group I; claims 1-7 and 10-26 read on Embodiment A; claims 1-7 and 10-26 also read on Embodiment 1.

An early action on the merits of both groups of claims is earnestly solicited.

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855.

Dated: November 4, 2004

Respectfully submitted,

By

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